

## **REMARKS**

This amendment is in response to the Office Action dated March 20, 2009 (the Action). Applicants appreciate the Examiner's withdrawal of certain previous rejections citing U.S. Patent No. 6,564,485 to Hess ("Hess") after arguments were presented by Applicants in the Request for Reconsideration after Final Action submitted September 18, 2008 and the Appeal Brief submitted December 9, 2008.

Applicants further appreciate the telephonic interview provided by the Examiner on April 15, 2009. Although agreement was not reached, a summary of Applicants' position in the telephonic interview is provided below, and additional arguments and amendments are presented. This paper shall constitute an Interview Summary under MPEP 713.04.

**In addition, Applicants hereby request an Examiner Interview prior to any subsequent Official Action.**

Support for the above amendments can be found, for example, on page 11, lines 1-27 of Applicants' Specification. Reconsideration of the rejections in the Action is respectfully requested in view of the amendments above and the remarks that follow.

### **I. The Rejections under 35 U.S.C. 112, Second Paragraph**

Claims 2-10 and 12-20 stand rejected under 35 U.S.C. 112, second paragraph. Applicants submit that the terms discussed on pages 2-3 of the Action have been amended above such that the rejections are made moot.

Accordingly, Applicants request that the rejection be withdrawn.

### **II. The Independent Claims**

#### **A. Claim 2**

Claim 2 stands rejected under 35 U.S.C. 102(b) as being anticipated by U.K. Publication No. 2298073A to O'Neill ("O'Neill"). Claim 2 is reproduced below (emphasis added):

2. A flame effect electric fire comprising:
  - i) a housing having at least first and second opposing external side panels, a top external panel and an opposing bottom underside

external panel, wherein the first side panel of the housing is adapted to be mounted on a substantially plane wall and the bottom underside external panel includes a generally horizontal portion;

ii) a fan heater disposed in the housing and configured to draw air into the housing, heat the air and expel the heated air; and

iii) a flame simulating assembly mounted in the housing and comprising:

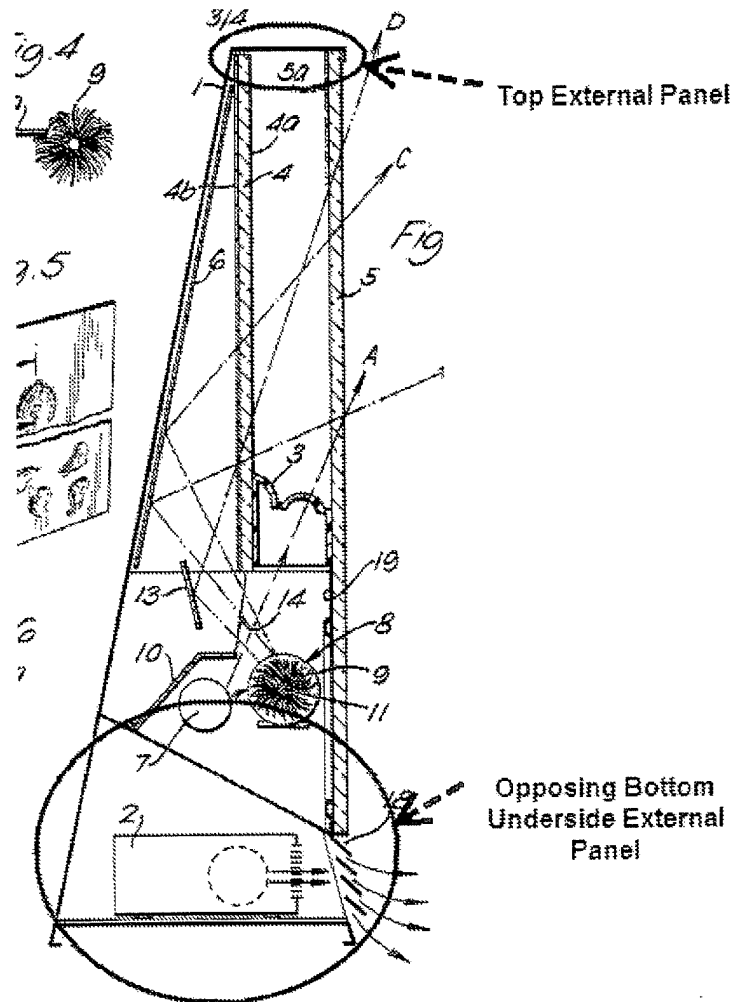
(a) a light source;

(b) a viewing screen on the second side panel capable of diffusing and transmitting light;

(c) a rear reflecting means disposed behind the viewing screen; and

(d) means for producing moving beams of light, wherein the light source is disposed below the reflecting means and behind the viewing screen, the means for producing moving beams of light is disposed in front of the light source and below the screen and light from the light source is reflected by the means for producing moving beams of light onto the reflecting means and is reflected by the reflecting means onto the screen to produce a perceptible image viewable on the screen, and wherein the fan heater expels air in a generally vertically downward direction through an air expulsion aperture in the generally horizontal portion of the underside external panel of the housing.

The Action takes the position that the opposing bottom underside external panel is disclosed in O'Neill by element 18 of Figure 3. Applicants initially note that the previous Official Action mailed July 18, 2008 conceded that an opposing bottom underside external panel was **not** disclosed by O'Neill. See Official Action mailed July 18, 2008, page 7. The current Action provides no explanation regarding this inconsistency in position. Figure 3 of O'Neill as annotated in the action is reproduced below.



O'Neill, Fig. 3 as annotated in the Action, page 6.

Applicants submit that O'Neill does not disclose an opposing bottom underside external panel as conceded in the previous Official Action mailed July 18, 2008 because element 18 is clearly shown on a side panel that is not opposite the top external panel. However, in order to expedite prosecution, Claim 2 has been amended to recite that the fan heater expels air in a generally vertically downward direction through an air expulsion aperture in the generally horizontal portion of the underside external panel of the housing. The element 18 that is newly identified in the Action as analogous to the opposing bottom underside external panel clearly does not disclose a generally horizontal portion of the underside external panel of the housing as recited in Claim 2.

Accordingly, O'Neill does not disclose every element of the claims as required by 35 U.S.C. 102(b). Moreover, Applicants submit that it would not be obvious to modify O'Neill to expel air in a generally vertically downward direction through an air expulsion aperture in the generally horizontal portion of the underside external panel of the housing because the device in O'Neill is configured to be supported by a horizontal surface such as a floor, and it would be undesirable to direct heated air towards the horizontal surface. *See Applicants' Specification, page 11, lines 1-27.*

In addition, the missing elements of O'Neill are not provided by any of the secondary reference cited with respect to the dependent claims.

For at least the above reasons, Applicants submit that Claim 2 is patentable over the cited prior art. Claims 3-9, 12-17 and 19 depend from Claim 2 and are patentable over the cited prior art for at least the reasons discussed with respect to Claim 2. Accordingly, Applicants request that the rejection of Claims 2-9, 12-17 and 19 be withdrawn.

**B. Claim 10**

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill in view of U.S. Patent No. 2,984,032 to Cornell ("Cornell"). Claim 10 recites as follows:

10. An apparatus for producing a visual effect for simulating flames comprising:
  - i) a light source;
  - ii) a simulated fuel bed;
  - iii) a viewing screen mounted about the fuel bed capable of diffusing and transmitting light and comprising a partially reflective front surface whereby an image of the fuel bed is visible in the viewing screen;
  - iv) means for producing moving beams of light, wherein:
    - a) light from the light source is reflected by the means for producing moving beams of light onto the viewing screen to produce a perceptible image viewable on the screen; and
    - b) the means for producing moving beams of light comprises a shaft mounted for rotation about its axis and having a reflective material mounted thereon for reflecting light from the light source, the shaft is driveably connected at a first end thereof via a flexible bushing to a drive means operative to rotate the shaft and is releasably retained at a second end thereof in a supporting bracket, the first end of the shaft being configured to be retained by the flexible bushing when the second end is

released from the supporting bracket and the shaft being displaceable from its operative position on release of its second end by flexure of the flexible bushing, thereby to permit access to the light source.

The Action takes the position that the term "configured to" is deemed "functional language" that is allegedly "does not limit a claim to any particular structure." *See* the Action, page 21 (citing MPEP 2111.04). As best understood by Applicants, the Action is apparently taking the position that the following language does not recite structure:

the supporting bracket having a slot therein adjacent the second end of the shaft, the first end of the shaft being configured to be retained by the flexible bushing when the second end is released from the supporting bracket via the slot in the supporting bracket, and the shaft being displaceable from its operative position on release of its second end by flexure of the flexible bushing, thereby to permit access to the light source

*See* the Action, page 21.

The Action overlooks significant portions of MPEP 2111.04, which is cited repeatedly in the Action. MPEP 2111.04 clearly states that the "determination of whether each of these clauses [*e.g.*, "adapted to," which the Action alleges is analogous to "configured to"] is a limitation depends on the specific facts of the case. *See* MPEP 2111.04. **"A functional limitation must be evaluated and considered, just like any other limitation of the claim,** for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." *See* MPEP 2173.05(g) (emphasis added). For example:

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

MPEP 2173.05(g) (citing *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976))(emphasis added).

Applicants submits that the use of the term "configured to" in Claim 10 serves to precisely define structural attributes of interrelated component parts as discussed in MPEP

2173.05(g) and *Venezia*. In addition, additional recitations in Claim 10 that are clearly not functional language are also not disclosed in Cornell and/or O'Neill.

In particular, Claim 10 recites that "the shaft is driveably connected at a first end thereof via a flexible bushing to a drive means...and is releasably retained at a second end thereof in a supporting bracket..." This recitation of Claim 10 does not even recite "functional" language; however, the Action appears to improperly ignore this recitation. Cornell discusses that one end of the shaft **32** is journaled in a bearing **36**, and the other end includes a resilient sleeve **40** (which the Action states is analogous to the claimed flexible bushing). Cornell discusses disconnecting the shaft **32** at the end having the resilient sleeve **40**. See Cornell, col. 2, lines 40-44. Accordingly, the other end of the shaft **32**, which the Action apparently identifies as analogous to the second end recited in the claims, is journaled in a bearing **36**. As such, Cornell clearly does not meet the recitation that the shaft is releasably retained at a second end thereof in a supporting bracket where the first end is driveably connected via the flexible bushing as recited in Claim 10.

In addition, Claim 10 recites that the first end of the shaft is configured to be retained by the flexible bushing when the second end is released from the supporting bracket via the slot in the supporting bracket. The shaft end opposite the resilient sleeve **40** in Cornell (which the Action identifies as analogous to the flexible bushing) is journaled in a bearing **36**, and therefore, is retained when the resilient sleeve **40** permits release of the other shaft end. Thus, Cornell also does not meet the recitation that the first end of the shaft is configured to be retained by the flexible bushing when the second end is released from the supporting bracket.

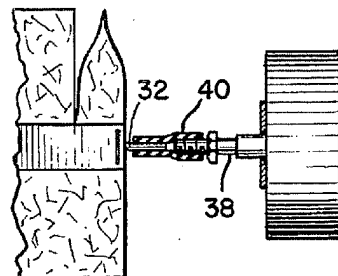
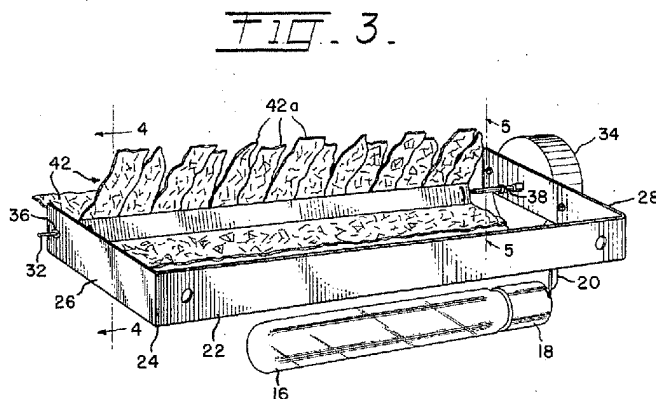


FIG. 5.

Moreover, because Cornell states that the resilient sleeve **40** (which the Action states is analogous to the claimed flexible bushing) is designed to make it "an easy matter to disconnect the shaft" at the resilient sleeve **40**, there is no apparent reason why one of ordinary skill would modify Cornell with any expectation of success to disconnect the shaft **32** at the bearing **36**.

In addition, the missing elements of Cornell and O'Neill are not provided by any of the secondary reference cited with respect to the dependent claims.

For at least these reasons, Applicants submits that the recitations of Claim 10 are not disclosed or rendered obvious by O'Neill and/or Cornell. Accordingly, Applicants requests that the rejection of Claim 10 under § 103 be withdrawn. Claims 18 and 20 depend from Claim 10 and are patentable over the cited art at least per the patentability of Claim 10.

### **III. Claim 9**

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill in view of Cornell and U.S. Patent No. 6,269,567 to MacPherson ("MacPherson").

Claim 9 depends from Claim 2 and is patentable at least per the patentability of Claim 2 discussed above. In addition, Claim 9 is separately patentable for at least the reasons that follow. Claim 9 recites as follows:

9. A flame effect electric fire as claimed in claim 8 wherein the shaft is driveably connected at a first end thereof via a flexible bushing to a drive means operative to rotate the shaft and is releasably retained at a second end thereof in a supporting bracket, the supporting bracket having a slot therein adjacent the second end of the shaft, the first end of the shaft being configured to be retained by the flexible bushing when the second end is released from the supporting bracket via the slot in the supporting bracket, and the shaft being displaceable from its operative position on release of its second end by flexure of the flexible bushing, thereby to permit access to the light source.

Accordingly, Claim 9 generally recites the subject matter discussed above with respect to Claim 10, and is separately patentable for similar reasons to those discussed above with respect to Claim 10.

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MacPherson is cited as merely disclosing a slot, and consequently, MacPherson does not provide the missing elements of Claim 9 emphasized above.

Applicants submit that Claim 9 is separately patentable for at least the reasons discussed above.

### CONCLUSION

Accordingly, Applicants submit that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,



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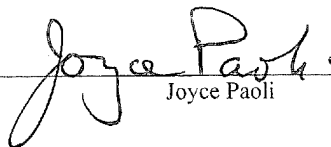
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Attachments

### CERTIFICATION OF TRANSMISSION

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